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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,134

05/30/2006

Johan Cornelis Talstra

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

DINH, TAN X

ART UNIT

PAPER NUMBER

2627

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/581,134	TALSTRA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	TAN X. DINH	2627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

1) This application is a **371** of **PCT/IB04/52545**, filed on **11/25/2004**.

Receipt is acknowledged of papers submitted under **35 U.S.C. 119(a)-(d) or (f)**. The certified copy of the priority documents have been received in this **National Stage Application** from the International Bureau (**PCT Rule 17.2(a)**).

The foreign document identifies as:

**EPO 03104509.9**, filed on **12/03/2003**.

2) The amendment/preliminary amendment filed **5/30/2006** is acknowledged. The amendment eliminates multiple dependent claims.

3) This application does not contain an abstract of the disclosure as required by **37 CFR 1.72(b)**. An abstract on a separate sheet is required.

4) The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in **37 CFR 1.77(b)**, the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "**Not Applicable**" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.

- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

5) Claims **1-13** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase " can be " ( claim 1 ) render(s) the claim(s) indefinite. The phrase " can be " has two meaning which indicates that the spiral can be described and cannot be described, that would make the resulting claim(s) do not clearly set forth the metes and bounds of the patent protection desired.

The phrase " certain standard specification " and "standard specification " ( claim 9 ) is indefinite because elements in the

art of varying size, dimensions, properties, etc., could all be considered to be conventional, standard or normal.

Claim(s) 2-13 incorporate the indefiniteness of claim(s) 1 by virtue of their dependency thereon.

6) Claims 12 *and* 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 12 *and* 13 are drawn to a “program” or “software” per se as recited in the preamble and as such are non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Claims to processes that do nothing more than install a program or software in a computer or concepts are non-statutory. If the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *SCHRADER*, 22 F.3d at 294-95, 30 USPQ 2d at 1458-59. Thus, a process consisting solely of mathematical operations without some claimed practical application or does not manipulate appropriate subject matter are not constitute a statutory process. In this case, the claims merely recite a program comprises software for detecting the side-channel (signals), which simply manipulates abstract ideas without some claimed practical application.

7) The following is a quotation of the appropriate

paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

8) (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9) Claims **1,3,4 and 8**, as understood by the meaning of 112, 2<sup>nd</sup> above, are rejected under 35 U.S.C. 102(b) as being anticipated by **KAJIYAMA et al ( 6,108,296 )**.

KAJIYAMA et al discloses a record carrier as claimed in claim 1, comprising a predetermined spiral which spiral can be described using parameters, the record carrier further comprising a side-channel encoded by the parameters being modulated in a predetermined way ( Fig.3, Laser 14, E/O Modulator 15 ).

As to claim 3, KAJIYAMA et al shows channel modulated is channel pit length ( Figures 1 and 2, pit length is T. see column 1, lines 12-29 ).

As to claim 4, KAJIYAMA et al shows channel pit length in a first area has different values than a second area ( the channel pit lengths has different values on different areas ).

As to claim 8, the track pitch is inherent in every optical recording medium.

As to claim 9, the recording carrier is always adhered to any standard specification.

As to claim 10, KAJIYAMA et al shows the side-channel is used in an information access and/or copy protection system ( column 2, line 59 to column 3, line 21 ).

As to claims 12 and 13, computer program or software for detecting side-channel is inherent in KAJIYAMA et al's optical disc ( the optical disc using side-channel for copy-protected, which include software or program for operating this function ).

10) Claims **1,8,9,10,12 and 138**, as understood by the meaning of 112, 2<sup>nd</sup> above, are rejected under 35 U.S.C. 102(b) as being anticipated by **BENTVELSEN ( 2002/0114460 )**.

BENTVELSEN discloses a record carrier as claimed in claim 1, comprising a predetermined spiral which spiral can be described using parameters, the record carrier further comprising a side-channel encoded by the parameters being modulated in a predetermined way ( paragraph [0003] ).

As to claim 8, the track pitch is inherent in every optical recording medium.

As to claim 9, the recording carrier is always adhered to any standard specification.

As to claim 10, BENTVELSEN shows the side-channel is used in an information access and/or copy protection system ( paragraph [0003] ).

As to claims 12 and 13, computer program or software for detecting side-channel is inherent in BENTVELSEN's optical disc ( the optical disc using side-channel for copy-protected, which include software or program for operating this function ).

11) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C.103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the



applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13) Claims 5-7 *and* 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **KAJIYAMA et al ( 6,108,296 )**.

KAJIYAMA et al discloses all the subject matter as claimed in claims 5 and 6, *except to specifically show that* channel bit length is modulated constant into different bands. However, the data in optical recording medium can be modulated into any suitable fashions, constant modulated within the band, variation modulated within the band, constant modulated in different bands, etc.,. Obviously, to modulated channel bit length on different bands as claimed is deem obvious to someone within the level of skill in the art.

Further, the bits formed on side-channel in optical recording medium is always encoded on each band.

14) Claim 2 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

15) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims ( if the rejection involves with any applicable arts ), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Form **PTO-892** is attached herein.

16) The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the Examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in it/their entirety since the other areas of the document(s) may be replied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portion that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. V. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. Denied. 469 US. 815 (1984). Furthermore, " the prior art merely disclose of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit or otherwise discourage

the solution claimed ....” In re Fulton F.3d 1195, 1201, 73 USPQ 2d 1141, 1146 (Fed. Cir 2004).

170 Any inquiry concerning this communication or earlier communications from the examiner should be directed to **TAN Xuan DINH** whose telephone number is **(571)272-7586**. The examiner can normally be reached on **Monday - Friday from 9:00AM to 5:00PM**.

The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the **Patent Application Information Retrieval (PAIR)** system. Status information for published applications may be obtained from either **Private PAIR** or **Public PAIR**. Status information for unpublished applications is available through **Private PAIR only**. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the **Private PAIR system**, contact the **Electronic Business Center (EBC)** at **866-217-9197** (toll-free).

/TAN Xuan DINH/  
Primary Examiner, Art Unit 2627  
June 19, 2009